REMARKS

Claims 1-4, 6-10, 12, 14-21, 48-50 and 52-61 are pending. The simultaneously filed RCE accompanying these Preliminary Remarks is filed following a Decision on Appeal dated December 19, 2008 that affirmed-in-part the final rejection of the claims and a Denial of a Request for Rehearing dated July 14, 2009.

While Applicant respectfully disagrees with may of the points in the Board's Decision on Request for Rehearing, Applicant has filed this RCE to clarify the record with respect to several points raised during the Appeal process. In particular a Declaration will be filed in the immediate future by Dr. Craig Horne. The Horne Declaration explains the data previously filed by in a Declaration by Drs. Horne and Chang. Also, the Horne Declaration provides further perspective on the position of a person of skill in the art.

Applicants respectfully request reconsideration of the rejections based on the following further comments.

Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 1-4, 6-10, 12-21 and 48-61 under 35 U.S.C. § 112, second paragraph as being indefinite. The Board of Appeals reversed this rejection. See Decision of December 19, 2008 of Appeal 2008-4615. This issue is not discussed further.

Rejection Over Kamauchi et al. and Manev

The Examiner rejected claims 1-4, 6, 7, 10, 12, 14-17, 19-21, 48-50, 52, 53 and 55-61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,538,814 to Kamauchi et al. (the Kamauchi patent) in view of U.S. Patent 5,789,115 to Manev (the Manev patent). The Board of Appeals affirmed this rejection. Applicant strenuously maintains that the Board made clear errors of law and fact in reaching their decision. However, there are factual issues that are

clarified in view of the Board opinion. A Declaration by Dr. Craig Horne will be filed in the immediate future to provide this clarification. Since there is no *prima facie* obviousness over the cited references and any showing of *prima facie* obviousness has been clearly overcome, Applicants respectfully request reconsideration of the rejection of claims 1-4, 6, 7, 10, 12, 14-17, 19-21, 48-50, 52, 53 and 55-61 under 35 U.S.C. § 103(a) as being unpatentable over the Kamauchi patent in view of the Manev patent.

To simplify the present discussion, Applicant incorporates by references their Appeal Brief dated May 14, 2007 with two corrected pages filed on June 26, 2007, Reply Brief filed November 29, 2007 and Request for Rehearing filed on December 29, 2009. Here, Applicant focuses on issues raised during appeal that are clarified for the record.

New Horne Declaration

Applicant sincerely apologizes that the conclusions of the data presented in the original Declaration of Drs. Horne and Chang was not sufficiently clear. The new Declaration of Dr. Horne will provide corresponding clarification. In particular, the average particle size is explained. In addition, the nature of the failure of the ground powders to meet the claimed uniformity is also explained in detail. Furthermore, Dr. Horne explains how the obtained results match the expectation from significant experience in the field how the ground powders would fail to meet the claimed uniformity.

In view of the Horne Declaration, it is clear that the teachings of the cited references fail to place Applicant's claimed invention in the hands of the public without undue experimentation. In other words, the teachings of the references do not provide a reasonable expectation of success. Since the teachings of the cited references do not provide a reasonable expectation of success with respect to practice of Applicant's claimed invention, the references do not render the claims *prima facie* obvious.

On page 10 of the Response to the Request for Rehearing, the Board stated the following: "Applicants' failure to determine the average particle size for the samples in the Horne Declaration renders the evidence insufficient to establish that Kamauchi's grinding process is incapable of producing Applicants' claimed composition having the average particle size and particle size distribution. Contrary to Applicants' argument, the average particle size of the samples is critical to analyzing the data. Applicants' claims require that the particle size distribution be measured relative to the average particle size, such that any determination that the Horne Declaration evidence shows that Kamauchi's grinding process cannot achieve the claimed particle size distribution would require knowing the average particle size of the samples."

Since this issue has now been rectified in view of the soon to be filed Declaration of Dr. Horne, it would seem that the claims are in condition for allowance. Applicant respectfully requests withdrawal of the rejection of claims 1-4, 6, 7, 10, 12, 14-17, 19-21, 48-50, 52, 53 and 55-61 under 35 U.S.C. § 103(a) as being unpatentable over the Kamauchi patent in view of the Manev patent. While Applicant does not acquiesce with respect to the particular issues related to the dependent claims, these issues are moot in view of the issues presented above.

Rejection Over Kamauchi et al. Manev et al. and Goodenough et al.

The Examiner rejected claims 8, 9 and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,910,382 to Goodenough et al. (the Goodenough patent) in view of the Kamauchi patent and the Manev patent as applied to the corresponding independent claims.
The deficiencies of the Kamauchi patent and the Manev patent are described in detail above. The Goodenough patent does not make up for the deficiencies of the Kamauchi patent and the Manev patent described in detail above. In particular, the Goodenough patent does not teach or suggest anything about particle size or uniformity with respect to electrode active compositions. Therefore, the combined teachings of the Kamauchi patent, the Manev patent and the

Goodenough patent do not render claims 8, 9 and 18 *prima facie* obvious. Applicants respectfully request withdrawal of the rejection of claims 8, 9 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the Goodenough patent in view of the Kamauchi patent and the Manev patent as applied to the corresponding independent claims. While Applicant does not acquiesce with respect to the issues relating to the dependent claims, Applicant does not discuss these issues further since they are moot in view of the discussion above.

Rejection Over Bodiger et al. and Bi et al.

The Examiner rejected claims 54, 58, 59 and 61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,849,827 to Bodiger et al. (the Bodiger patent) in view of U.S. Patent 5,952,125 to Bi et al. (the Bi patent). The Board reversed this rejection. This rejection is not discussed further.

CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

/Peter S. Dardi/

Peter S. Dardi, Ph.D.
Registration No. 39,650

Customer No. 62274
Dardi & Associates, PLLC
Suite 2000, U.S. Bank Plaza
220 South 6th Street
Minneapolis, Minnesota 55402
Telephone: (404) 949-5730